

Office Action Summary	Application No. 09/714,665	Applicant(s) URBANSKI ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,8,14,17,19,23,25,26,29,34,35,40-54 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,8,14,17,19,23,25,26,29,34,35,40-54 and 57-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>28 Jan 2009</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-54 and 58-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At each independent claim 40, 47 and 54 (e.g., at lines 8 and 9 of claim 40), “unrelated to said target location” is new matter. A negative limitation must have some basis in the original disclosure; it cannot be presumed (MPEP 2173.05(i)).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-54 and 58-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At each independent claim 40, 47 and 54 (e.g., at lines 8 and 9 of claim 40), “unrelated to said target location” is indefinite. For example, spec. p. 12, line 8 discloses “subject matter of interest to the user” as an example of contextual information. The target location must also be of interest to the user or else it would be pointless to target the location.
5. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and

Art Unit: 3688

bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.

6. The instant application contains no such clear definition for the phrase “contextual information”. In the instant case, the examiner is required to give the term “contextual information” its broadest reasonable interpretation, which the examiner judges to be any information used to target an ad.

Claim Rejections - 35 USC § 102 and 35 USC § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-43, 46-50, 53, 54, 60, 63 and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al. (US005948040A).
10. DeLorme et al. teaches (Independent claims 40 and 47 and 54) a computer implemented method, computer readable storage medium containing said method and a system of communicating information concerning a target location for which a user seeks information

Art Unit: 3688

from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said target location (*the Palisade restaurant* among restaurants along a user-selected route in Seattle, Washington, col. 49 line 60 to col. 50 line 8) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;

providing contextual information (input *food*, col. 24 lines 19-23) unrelated to said target location, about a characteristic of said user (*user preferences*, col. 7 lines 27-30);

at said server retrieving from a database at least one of a plurality of categories of sponsored information (col. 28 lines 1-6 and 56-64, and col. 47 lines 45-56) provided by exclusive sponsors (whoever bears the cost of the "15 % discount" promotion in dialog box **595**, Fig. 5D and col. 50 lines 23-31)¹ for said target location; and

delivering said sponsored information (the dialog box **595**) to said computing/communications device (a *PDA*, col. 14 line 66 to col. 15 line 8 and 72 line 62 to col. 73 line 5) over said network (the *Internet*, col. 8 lines 1-3), wherein said sponsored information is determined in part based on said provided contextual information (the *user's preference* for *food*).

11. DeLorme et al. teaches at the citations given above claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34 (where the user selections read on "characteristics of the user"), 35, 41, 42, 48, 49, 60, 63, and 66.
12. DeLorme et al. teaches claims 43 and 50 (col. 22 lines 7-11) and claims 46 and 53 (col. 21 lines 40-48).
13. Claims 44, 45, 51, 52, 58, 59, 61, 62, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US005948040A).
14. DeLorme et al. does not teach (claims 44 and 51) delivering sponsored information for a specific period of time. Advertising was commonly sold for a specific period of time at the time of the instant invention. Official notice of this common knowledge or well-known in the art statement was taken in the Office action mailed on 29 June 2007 (Para. 9). This

statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.) Claims 45 and 52 do not add effective limitations because the application does not provide a *clear definition* (MPEP § 2111.01) of "sub-division". Any division, down to that including only of one sponsor (e.g., *the Palisade restaurant*, para. 10 above) reads on claims 45 and 52.

15. DeLorme et al. does not teach (claims 58, 59, 61, 62, 64 and 65) that the contextual information is either demographic information related to the user or identification information related to said computing/communication device. "Contextual information" is interpreted as ad targeting information. Official notice is taken that it was well known at the time of the invention to target ads to users by their demography or by cookies placed on their computing/communication device, said cookies reading on "identification information related to said computing/communication device". Demography is one of the oldest bases for advertising (e.g., advertising cosmetics in women's magazines). Cookies have been used for more than a decade to store user preferences, which is a basis for targeting.
16. Traverse of the taking of Official Notice - On p. 12 of the response filed on 13 January 2009, applicant has traversed the examiner's taking of official notice (in para. 15 immediately above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. The basis of the rejection is that demography is one of the oldest bases for advertising. Applicant has provided no evidence or argument to refute that contention. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.
17. Claim 57 is rejected under 35 U.S.C. 102(a) as being anticipated by "Foreclosure Search", a website published on 25 January 1999.² Foreclosure Search teaches a computer implemented method of communicating residential real estate (*number of bedrooms and baths*) foreclosure information concerning a target location (*zip code*) for which a user seeks

¹ A "sponsor" is "a person that pays for a project or activity", Merriam-Webster's Collegiate[®] Dictionary, 10th ed.

² Squires (St. Petersburg Times, 23 August 1998) suggests the *Foreclosure Search* website was launched in or before August 1998.

Art Unit: 3688

residential real estate foreclosure information from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said geographical region (*zip code*) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;

at said server retrieving from a database at least one of a plurality of categories of real estate professional contact information (the *Contact Us* button on the webpage) related to residential real estate foreclosure provided by exclusive real estate professionals (the operators of the website) participating in residential real estate foreclosure transactions for said geographical region; and

delivering said sponsored information related to residential real estate foreclosure to said computing/communications device over said network.

18. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“wherein a network address of said computing/communication device is used as said geographical region data;”

Said “network address” is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention. It doesn't matter whether the network address or, for example, “Kansas City” is used as said geographical region data.

Response to Arguments

19. Applicant's arguments have been considered in the revised rejection.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of

Art Unit: 3688

the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached after Noon on Monday and Wednesday through Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
23. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
25. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
26. Applicant may have after final arguments considered and amendments entered by filing an RCE.

Art Unit: 3688

27. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

2 February 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688